

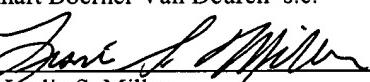
9-23-04

05/0678\$
JFCW

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EL531801359US with sufficient postage in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 22, 2004.

Reinhart Boerner Van Deuren s.c.

By:



Leslie S. Miller

Date: September 22, 2004

PATENT APPLICATION



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 3628

EXAMINER: FRANTZY POINVIL

In re application of: Edward G.)
McLaughlin and Flint A Lane)
Application No: 09/277,189)
Filed: March 26, 1999)
Attorney Docket No.: 7196-RCE)

) For: SYSTEM AND METHOD FOR
MANAGING MAIL/BILLS
THROUGH A CENTRAL
LOCATION

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 22, 2004

APPEAL BRIEF

Sir:

Appellants, pursuant to 37 C.F.R. § 1.192, hereby file in triplicate this brief as part of the appeal on the above-referenced patent application.

09/24/2004 GWORDDF1 00000036 09277189

02 FC:1402

330.00 OP

I. Statement of the Party of Interest

The party of interest in this application is Metavante Corporation, the recorded assignee of the entire title of the subject application.

II. Related Appeals and Interferences

There are no other related appeals or interferences.

III. Status of the Claims

Claims 1-30 are pending in the case, and are all finally rejected. Claims 1-30 are the subject of this appeal, and a copy of these claims is attached hereto as Appendix A.

IV. Status of Amendments

An October 17, 2003, amendment to the claims (Amendment D) was the last amendment to be made to the claims, and was entered and considered. There was no post-final rejection amendment, leaving Claims 1-30 pending.

V. Summary of the Invention

Applicants' invention is a method and system for electronically presenting bills which are capable of accepting and processing paper bills which are received from billers on behalf of customers by a service provider. Paper bills are converted into electronic bills by scanning them into electronic images and extracting billing information from the electronic images. The billing information which is so extracted is then validated. The extracted and validated billing information is then presented to the customer. The present invention provides a unique electronic bill presentation method and system which are

capable of dealing with paper bills generated by goods or service providers and presenting these bills to customers electronically, optionally together with bills which are generated by goods or service providers as electronic bills. As such, the system of the present invention is advantageous over prior art bill presentation systems capable of presenting only bills supplied by billers as electronic bills.

VI. Issues Presented for Review

The sole issue remaining in this application is whether independent Claims 1, 9, 13, 16, 24, and 28 (together with those claims depending therefrom) constitute patentable subject matter under 35 U.S.C. § 103. That is, were the claims obvious in view of the combination of references cited by the Examiner at the time the invention was made, which was at least as early as the filing date of March 26, 1999.

VII. Grouping of Claims

For the purposes of discussion herein, each independent claim and all claims depending therefrom are to be considered separately, inasmuch as the invention of each such claim or set of claims is separately and patentably distinguishable over the cited prior art.

VIII. Arguments

A. Brief Discussion of the References Cited.

1. **The Lamm Patent (U.S. Patent No. 6,078,907).** The Lamm patent is a method and system for use by a service provider to deliver electronic bills to a billed party. The billed party receives goods or services from a billing party, and, in a key requirement of the method and system taught by the Lamm reference, the billing party generates an electronic billing file. In the Lamm reference, neither the billing party nor anyone else ever generates a paper bill -- there quite simply is no paper bill contemplated by Lamm under any circumstances or any permutation. The Lamm method and system is incapable of working with paper bills, and in the Lamm reference there is not a single word implying anything to the contrary. Rather, the Lamm reference converts the electronic billing file received from the biller to a redacted bill file by redacting certain information. (This is done to create a standard electronic bill format which may be created from any of a number of different electronic billing file formats which may be received from different billers.) The Lamm reference then sends the electronic redacted bill file to the billed party, and the redacted bill file may be reconstructed at the billed party's computer by adding a standard bill component (the billing party's logo, for example) to be displayed as a bill resembling a paper bill on the billed party's computer.

2. **The Kolling et al. Patent (U.S. Patent No. 5,963,925).** The Kolling et al. patent is an electronic bill presentment system which, like the Lamm patent,

is only capable of accepting electronic billing information from billers and presenting it electronically to consumers. The Kolling et al. reference simply does not work with paper bills, and does not use paper statements or invoices in any way; in fact, there is not a single word in the entire Kolling et al. reference which deals with the issue of paper bills. Rather, the Kolling et al. reference "replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery." Abstract, lines 1-2 (emphasis added). The electronic statements, when displayed on the consumer's computer, have the same look as paper bills would have had (or formerly had).

3. The Walker Publication (Bank Systems & Technology, Vol. 36, Iss. 1, pg. S8, January, 1999). The Walker reference does not describe an electronic bill presentation system at all, but rather describes some of the characteristics of such systems on a high level in an extremely abbreviated summary fashion. The Walker reference states (with emphasis added) that: a. "customers may receive electronic bills directly from the biller or from a third party, such as a bill consolidator or a financial institution;" b. "billers must be able to accept enrollment information from many sources, validate the [enrollment] information, and change the way the customer's bill is processed and delivered" (from paper delivery to electronic delivery); c. "when a customer signs up for electronic delivery their next bill is automatically re-routed from the paper to the electronic process;" d. "if desired, this module can also send a paper bill and an electronic bill for a specified period;" e. "in a 'thick consolidator or outsource' model,

customers access all their bills at a consolidator's Web site and the biller merely sends the bill data to the consolidator;" and f. "customers gain the ability to pay many bills at or (sic) web site, but the biller loses direct contact with customers." In the Walker publication, there is not a single word about paper bills being converted into electronic bills; rather, electronic billing information is used both to send electronic bills to consumers and to generate paper bills which may also be sent to the consumer. In other words, the Walker publication discusses electronic billing information being used to produce paper bills rather than the converse.

4. **The PR NewsWire Publication (Wire Feed Document dated September 21, 1998).** The PR NewsWire publication does not describe an electronic bill presentation system in even summary detail, but rather, as stated by the Examiner, "relates to a National Processing Co. (NPC) that processes customer bills for Washington Water Power's national specialty billing and information services enterprise, Avista Advantage." Emphasis added. In the only words contained in the PR NewsWire publication which have any sort of detail at all, it states "NPC will open, prep and sort incoming utility bills from Avista clients. The variable data from each bill will be captured and transmitted to Avista Advantage for processing. NPC will also produce an electronic image of each bill and forward the image to Avista Advantage." Bill processing has nothing whatsoever to do with bill presentation, but rather takes involves the receipt of payment from the customers. In bill processing, the envelopes containing

the payment stub and check, or the payment stub containing credit card billing information, are opened, and data regarding the amount of payment (the amount paid by the customer), the nature of the payment (credit card or check), and financial account information (the credit card number or the checking account number) are obtained by scanning and extraction of the pertinent information, with images being retained as a backup in the event the data extraction was improperly performed. Most significantly, bill processing such as that described in the PR NewsWire publication has nothing to do with bill presentment, and the bill processing itself deals exclusively with the payment of paper bills which have not, and indeed could not be, presented electronically.

B. The Cited Prior Art References Have Been Misinterpreted and Are Unrelated to the Claimed Invention.

1. **The Kolling et al. Patent.** Despite the fact that it is not the first reference cited in the 35 U.S.C. § 103(a) rejection, the Kolling et al. patent is the primary reference relied upon by the Examiner in the January 13, 2004, Office Action. Critically, the Examiner relies upon the Kolling et al. reference to teach the scanning of paper bills required by the claims of the present patent application: "The plurality of bills is scanned (column 10, lines 7-20) and date therein are extracted and validated using a template (column 8, lines 52-67 and column 11) for generating an electronic statement..." This is incorrect, since the Kolling et al. reference teaches no such thing.

The Kolling et al. reference does not work with or use paper bills in any way, but instead completely replaces such paper bills with electronic bills which are created from electronic information supplied by the billers to the BSP (Biller Service Provider) and electronically delivered to CFS's (Customer Financial Institutions) which in turn deliver the electronic bills to the customers. The Kolling et al. reference does not ever scan a bill, or anything else -- despite the Examiner's assertion to the contrary regarding column 10, lines 7-20. It is clear that this description in fact refers to the Adobe Acrobat 3.0 software program, which includes capability to scan paper documents and convert them to electronic documents in Adobe's PDF format. As those familiar with Adobe Acrobat will appreciate, it is also capable of taking various types of electronic document formats as an input and converting them into electronic documents in the PDF format. In the Kolling et al. patent, Adobe Acrobat is one possible format for the electronic bills which are prepared from electronic information received from billers. Thus, the assertion that Kolling et al. extracts data from scanned documents is incorrect.

The assertion that the extracted data is "validated using a template (column 8, lines 52-67 and column 11) for generating an electronic statement" is also incorrect. In fact, what Kolling et al. does regarding the use of templates is to obtain necessary bill information from a variety of different electronic bill formats used by different billers. Kolling et al. uses a data table, which is also referred to as a template, for each biller, with each data table being nothing more than a list of the data fields which appear in a

statement from that biller to the consumers which are its customers. Different billers have different data fields, and hence need different data tables. The batched electronic billing data for each biller is sorted for individual consumers, and the sorted batched electronic billing data is used to generate electronic billing statements, which are then sent to the appropriate consumers. The Kolling et al. reference simply never uses templates as that term is used in the present application.

This is completely different than the use of the word "template" in the present patent application, in which a template is created "that contains zone information for locating the required billing summary data ... on the paper bill. ... The required billing summary data zones include bill date, bill amount, minimum due, due date, account number and consumer name and address." Specification, page 19, line 13-15 and 18- 20, and Fig. 4. Thus, it is readily apparent that the word "template" as used by Kolling et al. is used with a completely different meaning than its use in the present invention. It is thus apparent that the Kolling et al. reference does not teach what it is asserted in the January 13, 2004, Office Action that it teaches.

2. **The Lamm Patent.** The Examiner also relies upon the Lamm patent to teach that "[b]ills are received from a plurality of billers and scanned and identified. (Column 10, lines 18-63)" This is completely incorrect and misrepresents what the Lamm reference teaches, and the word "scan" or any variations thereupon such as "scanned" is not found anywhere in the entire Lamm reference. There are never any

paper bills contemplated in the entire process as described by Lamm, and there is (and indeed in view of what Lamm does there can be) no scanning.

What Lamm does teach is that electronic bill print files are obtained from billing parties and are subjected to a "redacting" process. As mentioned above with regard to Kolling et al., electronic data obtained from billers have different data fields, and the necessary data must be extracted from these data fields. Since electronic bill print files contain all information which would be printed on a paper bill if one were printed, information such as logos, advertisements, instructions, etc. must be redacted in order to obtain the billing information needed to prepare electronic bills in a common format.

The Lamm reference does not use templates as that term is used in the present application in any way, in which a template is created "that contains zone information for locating the required billing summary data ... on the paper bill. ... The required billing summary data zones include bill date, bill amount, minimum due, due date, account number and consumer name and address." Specification, page 19, line 13-15 and 18- 20, and Fig. 4. The redacting process used by Lamm is used for a completely different purpose than the use of a template in the present invention. Thus, it is apparent that the Lamm reference does not teach what the Examiner asserted in the January 13, 2004, Office Action that it teaches.

3. The Walker Publication. The Walker reference was challenged in Applicants' October 17, 2003, Amendment D as not satisfying the enablement provision

of 35 U.S.C. § 112, first paragraph, since the Walker reference merely summarily describes some of the characteristics of electronic bill presentation systems at a high level. Walker briefly describes changing from paper bills to electronic bills, but such a change as contemplated by Walker is clearly a mere substitution rather than using paper bills to generate electronic bills. Walker also describes sending both paper and electronic bills, but there is no indication that a paper bill is used as the basis for the electronic bill (those skilled in the art would not do this since the same electronic information can be used to generate both a paper bill and an electronic bill).

In the January 13, 2004, Office Action, Applicants' assertion that Walker was not enabling was unchallenged by the Examiner, who responded by stating that he "has not based the rejection solely on the Walker and/or PR NewsWire references." Applicants maintain that it is error to have even used the Walker publication as a reference in a Section 103(a) combination rejection if it is not enabling of anything contained in the claims, and the Examiner has not challenged Applications assertion that this is the case. In any event, the Walker publication's discussion of electronic billing information being used to produce paper bills rather than the converse is irrelevant to the claims in the present application, and Walker is not pertinent to any of those claims.

4. The PR NewsWire Publication. The PR NewsWire reference indicates that a first company (NPC) is doing bill processing for a second company (Avista Advantage). Bill processing has nothing whatsoever to do with bill presentment,

but rather deals with processing the receipt of payment from customers. As summarily described in the PR NewsWire reference, "NPC will open, prep and sort incoming utility bills from Avista clients. The variable data from each bill will be captured and transmitted to Avista Advantage for processing. NPC will also produce an electronic image of each bill and forward the image to Avista Advantage." It is apparent from this description that the PR NewsWire publication is referring to the processing of conventional paper payments from utility customers, which quite clearly indicates that there has been no use of electronic bill presentment. Thus, the PR NewsWire is completely irrelevant to the present invention, which is unrelated to the processing of bill payments.

While the Applicants' assertion (in the October 17, 2003, Amendment D) that the PR NewsWire publication does not satisfy the enablement provision of 35 U.S.C. § 112, first paragraph was unchallenged by the Examiner, it is believed to be moot in view of the fact that the PR NewsWire reference is completely unrelated to bill presentment.

C. The Combination of References Cited in the 35 U.S.C. § 103(a)

Rejection Does Not Teach the Claimed Invention. It is axiomatic that the claims are the measure of the invention. The claims are quite simply not taught by the references cited in the January 13, 2004, Office Action, due in large part to the fact that all four of the references were misconstrued in the January 13, 2004, Office Action. In fact, each of independent Claims 1, 9, 13, 16, 24, and 28 has multiple features included in the

language thereof which features are not taught or suggested in the cited references. In addition, the key to a proper determination of obviousness involves casting oneself back in time to the time the invention was made, which in this case is at least as early as March 26, 1999. Applicants submit that it is evident that one skilled in the art, with knowledge of the four references cited by the Examiner, would in fact not have made the combination suggested by the Examiner.

1. **The Lamm, Kolling et al., Walker, and PR NewsWire**

References Do Not Teach the Claimed Invention. As mentioned above, the Examiner has completely misinterpreted what the references teach, and they do not teach what is in the language of the claims. Each and every one of independent Claims 1, 9, 13, 16, 24, and 28 contains at least five steps (or means for performing such steps) which are not taught or suggested in any of the four references cited in the January 13, 2004, Office Action. These five steps are: a. receiving at least one paper bill for a customer from a biller; b. scanning the paper bill to generate electronic image information; c. extracting billing information from the electronic image information; d. validating the billing information extracted from the scanned paper bill; and e. presenting extracted billing information representative of a paper bill to the customer. Amazingly, none of these five steps are taught or suggested by any of the four cited references.

a. **The Lamm, Kolling et al., Walker, and PR NewsWire**

References Do Not Teach Receiving At Least One Paper Bill for a Customer from a Biller. The limitation of receiving (or having means for receiving) at least one paper bill for a customer from a biller is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"receiving at least one paper bill for said customer from at least one of said billers;"
9	"receiving and processing a paper bill for a customer;"
13	"receiving a paper bill for a customer;"
16	"means for receiving at least one paper-based bill for said customer from at least one of said billers;"
24	"means for receiving a paper bill for a customer;"
28	"means for receiving a paper bill for a customer;"

Lamm does not deal in any way with paper bills, and the system described in Lamm receives only electronic bill print files from billers. Kolling et al. does not work with or use paper bills in any way, but instead completely replaces such paper bills with electronic bills which are created from electronic information supplied by the billers to the BSP. Walker briefly describes changing from paper bills to electronic bills, and sending both paper and electronic bills, but there is no indication that a paper bill is ever received by a service provider. PR NewsWire does not deal with sending any kind of

bills under any circumstances, but rather deals with processing paper bills received with payment from customers, and is thus irrelevant.

Applicants assert that it is plain that the limitation of receiving (or having means for receiving) at least one paper bill for a customer from a biller, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that that the § 103 rejection is erroneous, and must be withdrawn.

b. The Lamm, Kolling et al., Walker, and PR NewsWire

References Do Not Teach Scanning a Paper Bill to Generate Electronic Image

Information. The limitation of scanning a paper bill to generate electronic image information is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"scanning said at least one paper bill received for said customer to generate electronic image information;"
9	"scanning said paper bill received for said customer to generate electronic image information,"
13	"scanning said paper bill received for a customer to generate electronic image information,"
16	"means for scanning said at least one paper bill received for said customer to generate electronic image information;"
24	"means for scanning said paper bill received for said customer to generate electronic image information;"
28	"means for scanning said paper bill received for said customer to generate electronic image information;"

Lamm does not scan bills or anything else -- the Lamm reference never even mentions the word scan, and, of course, it would be an impossibility to scan something which it never receives (Lamm does not receive paper bills, as mentioned above).

Kolling et al. also does not scan bills or any other paper item, since it has completely replaced such paper bills with electronic bills which it creates using the electronic information it receives from billers. The fact that Kolling mentions Adobe Acrobat, which is capable of scanning paper documents is irrelevant, since Kolling et al. is specifically not using Adobe Acrobat for this purpose, but rather is using Adobe Acrobat's PDF format for electronic bills which are generated from electronic billing information rather than from paper bills.

Walker never mentions anything about scanning, and teaches away from scanning since Walker specifically contemplates changing from paper bills to electronic bills. PR NewsWire does not deal with the billing process in any way, but rather deals with processing paper bills received with payment from customers, and is thus irrelevant.

Applicants assert that it is plain that the limitation of scanning a paper bill to generate electronic image information, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that that the § 103 rejection is erroneous, and must be withdrawn.

c. **The Lamm, Kolling et al., Walker, and PR NewsWire**

References Do Not Teach Extracting Billing Information from the Electronic Image Information. The limitation of extracting billing information from the electronic image information is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"extracting billing information from said electronic image information,"
9	"extracting billing information from said electronic image information using an optical character recognition process,"
13	"extracting billing information from said electronic image information using an optical character recognition process,"
16	"means for extracting billing information from said electronic image information;"
24	"means for extracting billing information from said electronic image information using optical character recognition,"
28	"means for extracting billing information from said electronic image information using an optical character recognition process,"

By definition, neither Lamm nor Kolling et al. nor Walker can perform this limitation since they do not receive paper bills or scan paper bills to produce electronic image information, as discussed above. Lamm receives print files, which are not electronic images produced from scanning, but which are instead the electronic file which would be sent to a printer to print a bill. Lamm uses a "redacting" process to ignore characters in the print stream which do not relate to the billing information to be collected. Thus, Lamm picks and chooses which characters to collect and which to ignore, which is not what the limitation in the claims is directed to. The claim limitation is directed to extracting billing information from electronic image information, which Lamm does not do (and cannot do, since the electronic print files are not electronic image information as that term must be construed in the present patent application).

Kolling et al. was cited for storing bills in an electronic database, and for its use of a "template." As mentioned in detail above, the "template" used in Kolling et al. is really a data table, which is merely a list of the data fields which appear in a statement from a Biller to a Consumer. The word "template" as used in the claims of the present invention are to "allow specific data contained in the paper bill in specific locations to be automatically identified." This is clearly a completely different use of the word, and despite repeated arguments in multiple amendments and in the February 26, 2002, Response, the Examiner has ignored this clear distinction. In view of the clear and unequivocal description in Kolling et al. of this function, it is evident that Kolling et al. does not extract billing information from electronic image information.

Walker describes changing from paper bills to electronic bills, a situation in which there is no billing information to extract since the bills are by definition sent electronically. PR NewsWire does not deal with the billing process in any way, but rather deals with processing paper bills received with payment from customers, and is thus irrelevant.

Applicants assert that it is plain that the limitation of extracting billing information from the electronic image information, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that the § 103 rejection is erroneous, and must be withdrawn.

d. The Lamm, Kolling et al., Walker, and PR NewsWire

References Do Not Teach Validating the Billing Information Extracted from the

Scanned Paper Bill. The limitation of validating the billing information extracted from the scanned paper bill is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"validating the extracted billing information generated from said scanned paper bill;"
9	"validating the extracted billing information generated from said scanned paper bill;"
13	"validating the extracted billing information generated from said scanned paper bill;"
16	"means for validating the extracted billing information generated from said scanned paper bill;"
24	"means for validating the extracted billing information generated from said scanned paper bill;"
28	"means for validating the extracted billing information generated from said scanned paper bill;"

Lamm selects which characters it uses and which characters it ignores in an electronic print file, and, since Lamm does not use optical character recognition, there is no need to perform a validation step. Indeed, one cannot validate a digital number which represents a character -- this is both an advantage of digital characters over analog scanned characters, and a clear reason why Lamm cannot possibly perform this step (and indeed, the Examiner has not asserted that Lamm has).

Kolling et al. is asserted by the Examiner to teach validating using a template, but this is not the case, as has been established above. The Examiner's reliance on the mere mention of Adobe Acrobat, which can scan documents (but is not used to do so in Kolling et al.) is misplaced. Rather, Kolling et al. selects a common subset of data fields (referred to as a "template" in Kolling et al.) which are sent by the various billers, which is necessary in order for a BSP to have a common set of data to send in electronic bills originating from more than one biller. It is clear that Kolling et al. does not validate extracted billing information generated from a scanned paper bill.

Walker involves changing from paper bills to electronic bills, and does not contemplate extracting information from paper bills. Information that is not produced or extracted cannot by definition be validated. Walker validates enrollment information, meaning that the information relating to the customer and the customer's account to establish an electronic billing relationship is validated (to prevent fraud), but this validation bears no similarity to the validation of extracted billing information generated from a scanned paper bill. PR NewsWire does not deal with the billing process in any way, but rather deals with processing paper bills received with payment from customers, and is thus irrelevant.

Applicants assert that it is plain that the limitation of validating the billing information extracted from the scanned paper bill, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the

references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that that the § 103 rejection is erroneous, and must be withdrawn.

e. The Lamm, Kolling et al., Walker, and PR NewsWire

References Do Not Teach Presenting Extracted Billing Information Representative

of a Paper Bill to the Customer. The limitation of presenting extracted billing

information representative of the paper bill to the customer is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"presenting said at least one electronic bill and said extracted billing information representative of said at least one paper bill to said customer."
9	"presenting said extracted billing information representative of said at least one paper bill to the customer."
13	"presenting said extracted billing information representative of said paper bill to the customer;"
16	"means for transmitting information that enables said customer to view at least one electronic bill and said extracted billing information representative of said at least one paper bill to said customer."
24	"means for transmitting said extracted billing information representative of said at least one paper bill to said customer."
28	"means for transmitting said extracted billing information representative of said paper bill to the customer;"

As is evident from the foregoing discussion, Lamm, Kolling et al., and Walker do not have billing information which has been extracted from scanned electronic image information. Thus, they are each incapable of meeting this limitation of the claims. PR

NewsWire does not deal with the billing process in any way, but rather deals with processing paper bills received with payment from customers, and is thus irrelevant.

Applicants assert that it is plain that the limitation of presenting extracted billing information representative of the paper bill to the customer, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that that the § 103 rejection is erroneous, and must be withdrawn.

For the simple reason that there are no less than five elements of each of independent Claims 1, 9, 13, 16, 24, and 28 that are not taught or suggested by the cited references, Applicants maintain that the combination of Lamm, Kolling et al., Walker, and PR NewsWire does not teach the claimed invention. Claims 2-8, 10-12, 14, 15, 17-23, 25-27, 29, and 30, which are dependent claims, are all allowable as depending from allowable base claims, and contain further limitations which are not taught or suggested by the references (which will not be elaborated upon herein in view of the clear patentability of independent Claims 1, 9, 13, 16, 24, and 28). Claims 1-30 are patentable over the references cited in the January 13, 2004, Office Action, and the rejection must be withdrawn.

D. The 35 U.S.C. § 103(a) Rejection is Improper Due to Its Use of

Hindsight-Based Obviousness. "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the

finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In a rejection based upon a combination of components selected from different references, "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

In the present patent application, the Examiner has used a hindsight-based obviousness test in both of the § 103 rejections which has been rejected soundly and repeatedly by the Federal Circuit. "Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." Eocolochem, Inc. v. Southern California Edison Company, 227 F.3d 1361, 1371, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."

As a defense against such hindsight-based obviousness allegations by an examiner, the Federal Circuit has insisted on the existence of a valid reason to make the

combination. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

What the Examiner attempted to do in the § 103 rejection was to use the highly innovative and novel solution taught by the Applicants as a blueprint, with one reference as the main structural diagram, and the other three references for the elements present in the claims but missing from the primary reference. This is impermissible, as the Federal Circuit has noted in case after case. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

The proper analysis is whether there is something in one of the prior art references which are being combined which suggests the combination, and in the § 103 rejection the Examiner utterly failed to find (or even to look for) such a teaching or suggestion supporting the combination. "When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.,

730 F.2d 1452, 1462, 221 USPQ 481, 488). A brief look at the rejection quickly yields the inescapable conclusion that the Examiner's § 103 rejection was a textbook example of an improper combination of prior art references.

1. The Rejection Under § 103 Using the Lamm, Kolling et al., Walker, and PR NewsWire References is Improper Under 35 U.S.C. § 103(a). The Examiner has conceded that there is no teaching or suggestion in the references, and has stated that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning," citing In Re McLaughlin, 443 F2d 1392, 170 USPQ 209 (CCPA 1971). In Re McLaughlin has been supplanted by the more recent case law mentioned above which rejects any hindsight-based obviousness allegations. However, even In Re McLaughlin requires that such a reconstruction "takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure..." Emphasis added. That is clearly not the case in the rejection of the January 13, 2004 Office Action, in which the entire narrative clearly illustrates the Examiner's use of Applicants' claims as the recipe, and endeavors to find the ingredients for the references in the cited references.

There is in the January 13, 2004 Office Action absolutely no analysis of why one skilled in the art would combine the four disparate references. The entire discussion of why the references should be combined is contained in the paragraph bridging pages 3

and 4 of the January 13, 2004 Office Action. A brief review of the four sentences contained in that paragraph quickly establishes that it does not contain the required analysis, or indeed any analysis constituting an attempt to justify the combination:

a. The First Sentence "Thus, as can be clearly, seen, each of the individual references relate to obtaining a plurality of bills from a plurality of billers for presentment to one or more customers." This is true with regard to Lamm, Kolling et al., Walker, but the bills obtained are electronic bills and not paper bills as clearly required by each and every independent claim in the present patent application. The PR NewsWire reference, as mentioned above, has nothing to do with either the other three references or the present invention, since it describes bill payment processing. This sentence does not in any way indicate why one skilled in art would combine any one of the cited references with any other one of the cited references, far less combining the four references together.

b. The Second Sentence "The bills are transferred to the customers or are remotely accessed by the customers at a consolidator's site." Lamm, Kolling et al., Walker all discuss electronic bills being delivered to customers, but that is irrelevant to the invention claimed in the present invention, which does not claim to be the first invention delivering electronic bills to customers. Thus, this comment is irrelevant, as well as being incorrect as to the PR NewsWire reference, which describes bill payment processing rather than the delivery of bills to customers. Again, there is no

indication of why one skilled in art would combine any one of the cited references with any other one of the cited references, far less combining the four references together.

c. The Third Sentence "When combining the references, it is noted that customers must be enrolled in order to access the electronic bills from one or more billers." This pertinence of this sentence is not seen; it simply does not advance the Examiner's position since the enrollment of customers is completely irrelevant to the invention claimed in any of the independent claims. It certainly provides no indication of why one skilled in art would combine any one of the cited references with any other one of the cited references, far less combining the four references together.

d. The Fourth Sentence "Thus, the combination of Lamm, Kolling et al., Walker, and the PR NewsWire clearly suggests the claimed invention as noted above and as indicated in the prior Office Action and the Examiner has not based the rejection on improper hindsight." In other words, the Examiner's sole justification for the combination is to assert that one skilled in the art would just do it because the combination clearly suggests the invention. This is not an acceptable reason for making a combination of references, but it is a clear indication that the Examiner has, in fact, used improper hindsight. The real answer is readily apparent -- there is no motivation that would motivate one skilled in the art to combine any one of the cited references with any other one of the cited references, far less combining the four references together.

There cannot be a clearer example of error than this statement of the conclusion itself as being its own justification. The rejection using Lamm, Kolling et al., Walker, and PR NewsWire is an improper combination under the law and must be removed.

IX. Conclusions

The independent claims of the present application are drafted in a manner which clearly defines them over the prior art. The Examiner's combinations are each unsupportable examples of hindsight-based obviousness. In addition, even could the combinations be made without the use of hindsight (which they cannot), they do not teach the claimed invention. Accordingly, Applicants believe the invention as presently claimed to be novel and nonobvious over the cited art and other art of which Applicants are presently aware. Applicants accordingly respectfully request the removal of all rejections of pending Claims 1-30, and the allowance of the present application.

Respectfully submitted:

BY 
Leslie S. Miller
Attorney for Applicants
Registration No. 30,662

Reinhart Boerner Van Deuren s.c.
1000 North Water Street, Suite 2100
Milwaukee, WI 53202
(414) 298-8321

Customer No. 22922

APPENDIX A

1 1. (Original) A method of electronically presenting bills for at least one customer
2 having an account from which funds may be drawn, comprising the steps of:
3 allowing a customer to subscribe to a bill presentment system for receiving
4 electronic-based and paper-based bills for said customer;
5 notifying a plurality of billers that said customer has subscribed to said bill
6 presentment system, said billers including electronic-based billers and paper-based
7 billers;
8 receiving at least one electronic bill for said customer from at least one of said
9 billers;
10 receiving at least one paper bill for said customer from at least one of said billers;
11 identifying the contents of said paper bill;
12 scanning said at least one paper bill received for said customer to generate
13 electronic image information;
14 identifying the type of bill;
15 extracting billing information from said electronic image information, wherein the
16 billing information is extracted using a predefined template;
17 validating the extracted billing information generated from said scanned paper bill;
18 and

APPENDIX A

19 presenting said at least one electronic bill and said extracted billing information
20 representative of said at least one paper bill to said customer.

1 2. (Original) The method of claim 1, further comprising the steps of:
2 removing unnecessary material from said received paper bill;
3 forwarding importance documents from said received paper bill to said customer;
4 receiving a payment instruction from said customer to pay a bill;
5 drafting a payment on an account for the customer account; and
6 sending the payment to the biller that originated the bill.

1 3. (Previously Presented) The method of claim 2, wherein step of drafting a payment
2 comprises the step of printing a physical check on said account.

1 4. (Original) The method of claim 3, further comprising the step of printing a stored
2 scanned image of a remittance stub.

1 5. (Previously Presented) The method of claim 2, wherein step of drafting a payment
2 comprises the step of submitting an electronic payment.

APPENDIX A

1 6. (Original) The method of claim 5, wherein step of drafting a payment comprises
2 the step of submitting an electronic payment using one of an automated clearing house
3 network, a automated teller machine network, and a credit card network.

1 7. (Previously Presented) The method of claim 1, wherein step of scanning further
2 comprises the steps of:

3 extracting billing information from said electronic image information using optical
4 character recognition, wherein the billing information is extracted using a predefined
5 template for the type of bill identified; and
6 extracting an image of the payment remittance stub from said paper bill.

1 8. (Original) The method of claim 1, further comprising the step of presenting an
2 electronic image of a paper bill upon receipt of a request from the customer.

1 9. (Original) A method of electronically presenting and paying paper-based bills for
2 at least one customer having an account from which funds may be drawn, comprising the
3 steps of:
4 receiving and processing a paper bill for a customer;
5 identifying the contents of said paper bill;

APPENDIX A

6 scanning said paper bill received for said customer to generate electronic image
7 information, wherein the type of bill is identified;
8 extracting billing information from said electronic image information using an
9 optical character recognition process, wherein the billing information is extracted using a
10 predefined template for the type of bill identified;
11 validating the extracted billing information generated from said scanned paper bill;
12 extracting an image of the payment remittance stub from said paper bill; and
13 presenting said extracted billing information representative of said at least one
14 paper bill to the customer.

1 10. (Original) The method of claim 9, wherein the type of bill is identified based upon
2 unique numeric identifiers contained within said paper bill.

1 11. (Original) The method of claim 9, further comprising the step of:
2 printing a physical check on an account of the customer.

1 12. (Original) The method of claim 11, further comprising the step of printing a stored
2 scanned image of a remittance stub.

APPENDIX A

- 1 13. (Original) A method of electronically presenting and paying paper-based bills for
- 2 at least one customer having an account from which funds may be drawn, comprising the
- 3 steps of:
 - 4 receiving a paper bill for a customer;
 - 5 identifying the contents of said paper bill;
 - 6 scanning said paper bill received for a customer to generate electronic image
 - 7 information, wherein the type of bill is identified;
 - 8 extracting billing information from said electronic image information using an
 - 9 optical character recognition process, wherein the billing information is extracted using a
 - 10 predefined template for the type of bill identified, wherein each type of bill has an
 - 11 associated template which contains zone information for locating the billing information;
 - 12 validating the extracted billing information generated from said scanned paper bill;
 - 13 extracting an image of a payment remittance stub from said paper bill;
 - 14 storing said scanned image of said remittance stub for said paper bill;
 - 15 presenting said extracted billing information representative of said paper bill to the
 - 16 customer;
 - 17 receiving a payment instruction from said customer to pay said paper bill; printing
 - 18 a paper check on an account of the customer; and
 - 19 printing said stored scanned image of said remittance stub for said paper bill.

APPENDIX A

1 14. (Original) The method of claim 13, wherein step extracting billing information is
2 performed automatically.

1 15. (Original) The method of claim 14, wherein step extracting billing information
2 comprises the steps of:

3 identifying a type of bill based upon unique numeric identifiers contained within
4 said paper bill; and

5 extracting billing information from zones that are pre-defined for said type of bill.

1 16. (Original) A system for electronically presenting and paying bills for at least one
2 customer having an account from which funds may be drawn, comprising:

3 means for allowing a customer to subscribe to a bill presentment system for
4 receiving electronic and paper-based bills for said customer;

5 means for notifying a plurality of billers that said customer has subscribed to said
6 bill presentment system, said billers includes electronic-based billers and paper-based
7 billers;

8 means for receiving at least one electronic bill for said customer;

9 means for receiving at least one paper-based bill for said customer from at least
10 one of said billers;

APPENDIX A

11 means for scanning said at least one paper bill received for said customer to
12 generate electronic image information;
13 means for extracting billing information from said electronic image information;
14 means for validating the extracted billing information generated from said scanned
15 paper bill; and
16 means for transmitting information that enables said customer to view at least one
17 electronic bill and said extracted billing information representative of said at least one
18 paper bill to said customer.

- 1 17. (Original) The system of claim 16, further comprising:
2 means for receiving a payment instruction from said customer to pay a bill;
3 means for drafting a payment on an account for the customer; and
4 means for sending the payment to the billing that originated the bill.
- 1 18. (Original) The system of claim 17, wherein said means for drafting comprises
2 means for printing a physical check on said account.
- 1 19. (Original) The system of claim 18, wherein said means for printing also prints a
2 stored scanned image of a remittance stub.

APPENDIX A

1 20. (Original) The system of claim 17, wherein said means for drafting comprises
2 means for submitting an electronic payment.

1 21. (Original) The system of claim 20, wherein said means for submitting submits an
2 electronic payment using one of an automated clearing house network, a automated teller
3 machine network, and a credit card network.

1 22. (Original) The system of claim 16, wherein said means for extracting extracts
2 billing information from said electronic image information using optical character
3 recognition.

1 23. (Original) The system of claim 16, wherein said means for transmitting transmits
2 an electronic image of a paper bill upon receipt of a request from the customer.

1 24. (Previously Presented) A system for electronically presenting and paying paper-
2 based bills for at least one customer having an account from which funds may be drawn,
3 comprising:

4 means for receiving a paper bill for a customer;

5 means for scanning said paper bill received for said customer to generate
6 electronic image information;

APPENDIX A

7 means for identifying the type of bill;
8 means for extracting billing information from said electronic image information
9 using optical character recognition, wherein the billing information is extracted using a
10 predefined template for the type of bill identified;
11 means for validating the extracted billing information generated from said scanned
12 paper bill; and
13 means for transmitting said extracted billing information representative of said at
14 least one paper bill to said customer.

1 25. (Original) The system of claim 24, wherein said means for extracting comprises:
2 means for identifying a type of bill based upon unique numeric identifiers
3 contained within said paper bill; and
4 means for extracting billing information from zones that are pre-defined for said
5 type of bill.

1 26. (Original) The system of claim 24, further comprising means for printing a
2 physical check on an account of the customer.

1 27. (Original) The system of claim 26, wherein said means for printing also prints a
2 stored scanned image of a remittance stub.

APPENDIX A

- 1 28. (Previously Presented) A system for electronically presenting and paying paper-
- 2 based bills for at least one customer having an account from which funds may be drawn,
- 3 comprising:
 - 4 means for receiving a paper bill for a customer;
 - 5 means for scanning said paper bill received for said customer to generate
 - 6 electronic image information;
 - 7 means for identifying the type of bill;
 - 8 means for extracting billing information from said electronic image information
 - 9 using an optical character recognition process, wherein the billing information is
 - 10 extracted using a predefined template for the type of bill identified, wherein each type of
 - 11 bill has an associated template which contains zone information for locating the billing
 - 12 information;
 - 13 means for extracting an image of a payment remittance stub from said paper bill;
 - 14 means for validating the extracted billing information generated from said scanned
 - 15 paper bill;
 - 16 means for storing a scanned image of said remittance stub for said paper bill;
 - 17 means for transmitting said extracted billing information representative of said
 - 18 paper bill to the customer;

APPENDIX A

19 means for receiving a payment instruction from said customer to pay said paper
20 bill; and

21 means for printing a paper check on an account of the customer and said stored
22 scanned image of said remittance stub for said paper bill.

1 29. (Original) The system of claim 28, wherein said means for extracting operates
2 automatically.

1 30. (Original) The system of claim 29, wherein said means for extracting comprises:
2 means for identifying a type of bill based upon unique numeric identifiers
3 contained within said paper bill.